

reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Optivus Technology, Inc. v. Ion Beam Applications S.A.* 469 F.3d 978, 989 (C.A.Fed. 2006) citing *In re Kahn* 441 F.3d 977 (C.A.Fed. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994)).

1. The Examiner, at page 3 states that claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen, No. 5,353,564 in view of Davis, No. 3,766,644 and Graham, No 4,439,666.

The Examiner states that Hansen discloses a method and apparatus for using heat (col. 4, lines 35-49) to reduce condensate in a building interior having a ceiling 64 with an apex and a width from the ceiling apex to a wall 64; the interior wall surface having a height from a building foundation to the ceiling and but not heating with an embedded wire, temperature control, or moisture control.

The Examiner’s attention is drawn to Hansen at col. 4, lines 34-49 stating the following:

These objects are accomplished by use of a construction technique which provides for an interior wall and ceiling surface and an exterior wall and ceiling surface with **a between wall and ceiling air cavity. A forced air heating and/or cooling system is provided for directing ducted air** to the base of the **between wall cavity** for supplying heated air to the **between wall cavity** during periods of time when the outside atmosphere temperature falls below the desired inside storage temperature in order to hold the interior surface temperature above the dew point of the storage atmosphere. And, during periods of time when the outside atmosphere temperature exceeds the interior storage temperature, **for injecting cool air into the between wall air cavity for purposes of holding the interior wall surface temperature** to an acceptably low temperature.

The structural presence, in Hansen, of cavities and ducts between an interior and an exterior wall and ceiling, which received forced air, are structural features of primary importance in Hansen. The Examiner is also directed to Hansen, Claim 1 reciting an “air envelope...for circulating...air...” These features are not found in your applicant’s

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1 invention. Your applicant respectfully urges the Examiner to conclude that these
2 differences eliminates the Hansen structure from teaching a structure flowing toward the
3 structure of the present invention.

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5 The Examiner's attention is respectfully drawn to Davis. Davis is differentiated
6 from the present invention at Davis, col 2/lines 58-62 stating:

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8 "With the present invention, **the radiant heat**, while being **directed into the**
9 **interior of the room** is non-uniform and hence provides a more uniform heating
10 comfort, since concentration of heat on the body is avoided. Essentially, the
11 heating panel diffuses the radiant heat to provide more comfort.

12 The Examiner's attention is directed to your present Specification and the fact that
13 the present structure is directed to the heating solely of the surface (4) as seen at
14 Specification, page 7/line 31 to page 8/line 1 stating:

15 This allows the heat tape to maintain the temperature of the bottom board **such**
16 **that the interior surface is maintained at approximately 0.5 degrees over the**
17 **building interior temperature.**

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19 Your applicant respectfully urges the Examiner to conclude that Davis is
20 eliminated as a structure flowing toward the structure of the present invention. In light of
21 these distinctions in Hansen and Davis, your applicant respectfully urges the Examiner to
22 withdraw the rejection of claims 1-8 and 9-10.

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24 Additionally, claims are amended as follows:

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26 Claim 1 is currently amended as follows: "b. at least one heating means (60),
27 composed of heat tape (60) or a fluid heat transfer system means (60), in thermal

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1 communication with and affixed by...”

2 Claim 2 is currently amended as follows: “^{b.c.} b. the at least one heating means (60)
3 heat tape (60) or a fluid heat transfer system means (60) affixed by heating means (60)...”

4 Claim 4 is currently amended as follows: “~~a. the at least one heating means (60)~~
5 ~~composed of heat tape (60) or a fluid heat transfer system means (60);~~^{4a}
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7 Claim 5 is currently amended as follows: “a. the at least one heating means (60)
8 ~~composed of heat tape (60) or a ...~~”

9 Claim 6 is currently amended as follows: “ b. heating the at least one insulating
10 board means (7) with a heating means (60) , composed of heat tape (60) or a fluid heat
11 transfer system means (60), in thermal ...”
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22 **Law regarding 35 U.S.C. 103.**

23 The absence of a feature similar to the feature or features of the present invention
24 are respectfully argued as references which teach away from the disclosed and claimed
25 invention and thus are not appropriately a basis of rejection under 103. *KSR Intern. Co.*
26 *v. Teleflex Inc.* 127 S.Ct. 1727,1733 (U.S. 2007); *In re Gurley* 27 F.3d 551 at 553(1994
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1 cafc). In general a reference will teach away if the line of development flowing from the
2 references disclosure is unlikely to be productive of the result sought by the applicant.
3 *KSR, Id. 1733.*

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5 The Hansen duct structure for circulating air is a structure distinctly differing from
6 the present invention. The Davis structure comprises a heating element but differing in
7 structure from that seen in the present invention. Further, Davis is specifically taught as
8 heating the interior of a room. Your present invention heats solely the surface of the
9 board (4). Your applicant respectfully contends that both Hansen and Davis, separately
10 and in light of the other, are structures which teaches away from the structure of the
11 present invention. The art cited must be seen, separately and in combination, to teach
12 away from the invention disclosed and claimed by your applicant. The art cited does not
13 illustrate the structure of the present invention. There is no motivation to combine the
14 cited art to find taught or suggested the structure of the present invention.
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17 The Examiner has urged prior art alone and in combination as rendering obvious
18 the present invention. However, there is not demonstrated teaching, suggestion or
19 motivation to so combine the several components in the manner done by your present
20 applicant. Such recitation of prior art does not form a basis for rejection as obvious. *C.R.*
21 *Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1361, 48 USPQ2d 1225, 1240 (Fed. Cir.
22 1998), rehearing denied & suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed.
23 Cir. 1998) ("The ultimate question is whether, from the evidence of the prior art and the
24 knowledge generally available to one of ordinary skill in the relevant art, there was in the
25 prior art an appropriate teaching, suggestion, or motivation to combine components in the
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1 way that was done by the inventor."); *Chiuminatta Concrete Concepts, Inc. v. Cardinal*
2 *Industries, Inc.*, 145 F.3d 1303, 1312, 46 USPQ2d 1752, 1759 (Fed. Cir. 1998) ("for a
3 claim to be invalid for obviousness over a combination of references, there must have
4 been a motivation to combine the prior art references to produce the claimed invention.");
5 *Kahn v. General Motors Corp.*, 135 F.3d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998), cert.
6 denied, 119 S. Ct. 177 (1998); *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437,
7 1447, 45 USPQ2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998) ("there
8 is no suggestion or teaching in the prior art to select from the various known procedures
9 and combine specific steps, along with a new electrical structure, in the way that is
10 described and claimed by [the patentee]."); *Gambro Lundia AB v. Baxter Healthcare*
11 *Corp.*, 110 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383, 1384 (Fed. Cir. 1997) ("the
12 record must provide a teaching, suggestion, or reason to substitute computer-controlled
13 valves for the system of hoses in the prior art. The absence of such a suggestion to
14 combine is dispositive in an obviousness determination."; "Without a suggestion or
15 teaching to combine, [the accused infringer's] case of obviousness suffers a significant
16 deficiency."); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541, 41 USPQ2d 1829,
17 1833 (Fed. Cir. 1997) (the district court did not err in holding the patent in suit not invalid
18 for obviousness; the patent concerned a cut-resistant yarn for use in making products such
19 as gloves, which, unlike prior art yarns, did not use metallic components such as wire; the
20 yarn includes two core strands wrapped in opposite directions around two covering
21 strands; one core strand is fiberglass; the other core strand and the covering strands are
22 nylon or other material; the patent's claim required, inter alia, that there be a two strand

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1 core and that the covering strands be "wrapped about said core at the rate of 8-12 turns
2 per inch."; a prior art reference showed a yarn with a wrapping rate of 2-24 turns per inch,
3 but the reference disclosed the use of wire, and the accused infringer "has shown no
4 suggestion or motivation to modify the teaching of the [reference] with regard to non-
5 metallic fibers."); *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559, 1568, 39
6 USPQ2d 1321, 1327 (Fed. Cir. 1996) ("[N]one of the prior art references, alone or in
7 combination, teach or suggest a method [specified in the patent's claims]. The prior art
8 simply does not contain many limitations in the claimed method. Furthermore, the record
9 discloses no teaching or suggestion to combine any of these references. The absence of a
10 suggestion to combine is telling in an obviousness determination."); *B.F. Goodrich Co. v.*
11 *Aircraft Braking Systems Corp.*, 72 F.3d 1577, 37 USPQ2d 1314 (Fed. Cir. 1996),
12 discussed at N. 12.10(1) infra; *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*,
13 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996); *Beachcombers, International, Inc. v.*
14 *WildeWood Creative Products, Inc.*, 31 F.3d 1154, 1161, 31 USPQ2d 1653, 1659 (Fed.
15 Cir. 1994) (the patent claims in suit were not obvious in view of the prior art because the
16 art did "not remotely suggest configuring" the device as required by the claim);
17 *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d
18 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1993) ("When the patented invention is
19 made by combining known components to achieve a new system, the prior art must
20 provide a suggestion or motivation to make such a combination."). *Texas Instruments*
21 *Inc. V. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993) for
22 the proposition that obviousness is not supported where the references do not demonstrate
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1 to combine to produce the invention as presently disclosed.

2 The issue of viewing the present invention as a template is an inappropriate basis
3 for rejection on the basis of obviousness. Your applicant addresses the matter of a
4 “template” in light of the apparent marked structural distinctions between the cited art
5 and the present invention. The prior art “references in combination do not suggest the
6 invention as a whole claimed in the ... patent. Absent such a suggestion to combine the
7 references, respondents can do no more than piece the invention together using the
8 patented invention as a template.” *Heidelberger Druckmaschinen AG v. Hantscho*
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10 *Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993 where the
11 court held that “The motivation to combine references can not come from the invention
12 itself.”
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14 The applicant respectfully submits that the references, alone and in
15 combination, otherwise must constitute improper use of hindsight reconstruction. *In Re*
16 *Pleuddeman*, 910 F.2d 823, 828, 15 US PQ2d 1738, 1742 (Fed. Cir. 1990); *In Re*
17 *Mahurkar Patent Litigation*, 831 F.Supp. 1354, 28 US PQ2d 1801 (N.D. Ill. 1993). The
18 cases cited stand for the rule that decomposing an invention into its constituent elements,
19 finding each element in the prior art, and then claiming that it is easy to reassemble these
20 elements into the invention, is a forbidden ex post analysis. The applicant submits that it
21 is impermissible to use the claimed invention as an instruction manual or template to
22 piece together the teachings of the prior art so that the claimed invention is rendered
23 obvious. The references simply do not teach to combine the requisite features of your
24 applicant’s invention. “Before the PTO may combine the disclosures of two or more
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1 prior art references in order to establish Prima Facie obviousness, there must be some
2 suggestion for doing so, found either in the references themselves or in the knowledge
3 generally available to one of ordinary skill in the art.(*IN RE Jones*, 958 F.2d 347, 351, 21
4 USPQ2d 1941, 1943-44 (Fed. Cir. 1992)). "Evidence of a suggestion, teaching, or
5 motivation to combine prior art references may flow, inter alia, from the references
6 themselves, the knowledge of one of ordinary skill in the art, or from the nature of the
7 problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a
8 reference need not expressly teach that the disclosure contained therein should be
9 combined with another, *see Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461,
10 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in
11 whatever form, must nevertheless be "clear and particular." *Dembiczak*, 175 F.3d at 999,
12 50 USPQ2d at 1617." *Winner International Royalty Corporation v. Ching-Rong Wang*,
13 202 F.3d 1340(CAFC 2000).

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17 The applicant respectfully requests the Examiner to withdraw the 103 rejections
18 in light of the argument, amendments and responses submitted.

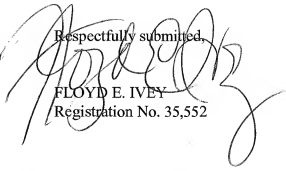
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20 The applicant has set forth arguments and law for the basis upon which prior art
21 cited under 35 U.S.C. 103 should not result in a conclusion of obviousness for the present
22 invention as specified and claimed. The applicant has presented features of the present
23 invention which are not found within the claims of either reference patent. The applicant
24 has presented law and argument to support the contention that the rejection of claims,
25 under 35 U.S.C. 103 should be withdrawn and now respectfully requests the Examiner to
26 withdraw the rejections.
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1 SUMMARY

2 The applicant has made a good faith effort to respond to the Examiner's Action
3 and respectfully requests the Examiner to withdraw the rejection of Claims 1-10 and to
4 allow the case to proceed to allowance.
5

6 Respectfully submitted,

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8 FLOYD E. IVEY
9 Registration No. 35,552

10 Telephone No. (509) 735-3581

11 *****

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13 Floyd E. Ivey, 35552.
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